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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,670	04/02/2002	Elmar Giehler	10191/1949	7979

26646 7590 07/16/2004 .

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

SHIMIZU, MATSUICHIRO

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,670

Applicant(s)

GIEHLER ET AL.

Examiner

Matsuichiro Shimizu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8–14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boschini (5,499,022) in view of Hiebl (6,496,100).

Regarding claim 8, Boschini teaches a method of keyless locking of a motor vehicle that includes a transponder (col. 5, lines 36–41, in response to request, badge 1 emits an identification signal 35) that exchanges a code with a transceiver, the motor vehicle including a control unit that compares the code with an expected code and, if a match is found, controls a closing system of the motor vehicle by locking the motor vehicle (col. 4, lines 62–65, locking process takes place when moved away from passenger space with the driver), the motor vehicle including at least one display (col. 7, lines 18–21, visual alarm) arrangement activated by the control unit and including at

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least one operating element on an operation of which a locking command is generated, the method comprising the steps of : causing the transceiver to deliver a search signal (col. 5, lines 36–41, activation of door handle) when the at least one operating element is actuated in order to determine a position of the transponder on the basis of the code sent back by the transponder (col. 6, lines 28–32, locking of the door when in zone 71'); activating the at least one display arrangement (col.7, lines 11–21, when the badge is inside vehicle, unlocking of door and triggering of a sound or visual alarm) when the transponder is at least one of in an interior of the motor vehicle and on a side of the motor vehicle opposite the actuated at least one operating element (col.7, lines 11–21, when the badge is inside vehicle, unlocking of door and triggering of a sound or visual alarm). But Boschini does not teach activating the closing system by locking the closing system when the at least one operating element is actuated again.

However, Hiebl teaches, in the art of vehicle door closing system, activating the closing system by locking the closing system when the user leaves the vehicle (col. 4, lines 50–61, locking switch 20 on the transponder 16) for the purpose of preventing the vehicle theft. Furthermore, one skilled in the art recognizes this closing operation is the second operation followed after the retrieving the transponder left in the vehicle, and therefore one operating element in the vehicle is actuated again. Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to include activating the closing system by locking the closing system when the at least one operating element is actuated again in the device of Boschini because Boschini suggest the at least one operating element is actuated in order to determine a position of the transponder on the basis of the code sent back by the transponder and one of ordinary skill in the art recognizes activating the closing system by locking the

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closing system when the at least one operating element is actuated again for the purpose of preventing the vehicle theft.

Regarding claim 9, Boschini teaches the method according to claim 8, wherein: the closing system is activated to lock the motor vehicle so that a vehicle door can be opened only by at least one internal operating element in the interior of the motor vehicle (col.7, lines 11–21, locking the door, and then unlocking the door when the badge is inside vehicle).

Regarding claim 10, Boschini teaches the method according to claim 8, wherein: the closing system is activated to lock the motor vehicle so that a vehicle door can be opened by an internal operating element only for a period of time (col.7, lines 11–21, unlocking of door and triggering of a sound or visual alarm).

Regarding claim 11, Boschini teaches the method according to claim 8, wherein: an opening of a vehicle door by an internal operating element is not possible after a period of time has elapsed (col. 7, lines 22–31, deactivation of badge inside vehicle after 10 second).

Regarding claim 12, Boschini teaches the method according to claim 8, further comprising the step of deactivating the transponder, when recognized in the interior, so that the code sent by the transponder is not recognized as permissible (col. 7, lines 22–31, deactivation of badge inside vehicle after 10 second).

Regarding claim 13, Boschini teaches the method according to claim 8, further comprising the step of storing additional information in a memory on deactivation of the transponder located in the interior of the motor vehicle (col. 7, lines 22–31, deactivation of badge in the vehicle).

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Regarding claim 14, Boschini teaches the method according to claim 8, wherein: an activation of the transponder that has been deactivated occurs on unlocking the closing system (col. 7, lines 22-31, deactivation occurs on unlocking the closing system beyond 10 seconds).


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matsuichiro Shimizu whose telephone number is (703) 306-5841. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik, can be reached on (703-305-4704). The fax phone number for the organization where this application or proceeding is assigned is (703-305-3988).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-8576).

Matsuichiro Shimizu

July 12, 2004



BRIAN ZIMMERMAN
PRIMARY EXAMINER